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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marcraft Clothes, Inc.

Serial No. 78142544

Ira E. Silfin of Amster, Rothstein & Ebenstein LLP for
Marcraft Clothes, Inc.

Jennifer M. Martin, Trademark Examining Attorney, Law
Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Quinn, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On July 10, 2002, Marcraft Clothes, Inc. (a New York corporation) filed an application to register on the Principal Register the mark EAGLE for "men's tailored clothing, namely, suits, sport jackets, coats and slacks." The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its

identified goods, so resembles two registered marks, both currently owned by Phillips-Van Heusen Corporation through assignment, and both for the mark EAGLE, Registration No. 110603 issued June 6, 1916 (renewed to 2006) for "woven dress-shirts, negligee shirts, and undershirts, drawers, and sleeping garments," and Registration No. 986469 issued June 18, 1974 (renewed to 2014) for "shirts, swim trunks, sweaters and neckties," as to be likely to cause confusion, mistake or deception.¹

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard*

¹ The Examining Attorney originally cited six registrations under Section 2(d) of the Trademark Act. Applicant successfully petitioned to cancel four of the six registrations. (Cancellation No. 92040797, *Marcraft Clothes, Inc. v. Cliftex Corporation*)

Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Examining Attorney correctly argues that applicant's mark and the two cited registered marks are identical. Therefore, the marks are not only similar, but are identical in sound, appearance, connotation and overall commercial impression. This fact "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Indeed, the fact that an applicant has selected the identical mark of a registrant "weighs [so] heavily against the applicant that applicant's proposed use of the mark on "goods... [which] are not competitive or intrinsically related [to registrant's goods]...can [still] lead to the assumption that there is a common source." *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993). "The greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of likelihood of confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 2001).

Applicant contends that the cited mark is weak and argues specifically as follows:

Because the EAGLE element shared by Applicant's Mark and the Cited Marks is weak and has been diluted by third [-] party use in the clothing field, confusion as to source or origin is not likely;

As indicated in the attached print-out from the [private] online database (Attached A), there are numerous existing registrations, in International Class 25 for clothing, which incorporate the EAGLE element including: [applicant then shows a typed list of 28 third-party registrations which include the word EAGLE];

These marks illustrate the narrow scope of protection afforded the Cited Marks and the recognition given by the Trademark Office of the public's ability to distinguish among close marks in this area (brief, pp. 2-3); and

Third[-]party uses and registrations can also provide evidence that the consumers of the goods in question are accustomed to distinguishing between similar goods and similar marks, and are less likely to be confused (brief, p. 6).

Procedurally, regarding applicant's "Attached A" (filed with its response dated April 24, 2003), applicant did not provide proper copies of any of the referenced third-party registrations/applications from the USPTO's database, but rather applicant's printouts are from a private online database. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24

USPQ2d 1230 (TTAB 1992); and In re Duofold Inc., 184 USPQ 638 (TTAB 1974). However, because the Examining Attorney did not object to this evidence, and in fact, she discussed the material on the merits, the Board considers all of the references (applicant's "Attached A" and applicant's typed list of 28 registrations) stipulated into the record.²

One of the third-party registrations from applicant's typed list is not in the printouts from the private online database and it is not for goods in International Class 25. (Registration No. 2677145 for the word "eagle" in lower case and in stylized lettering is for various hockey sporting goods in International Class 28.) In addition, with only five exceptions,³ all of the remaining marks both in the printouts and in applicant's typed list are for marks with the word EAGLE and at least one other word (for

² We note that the private database listings do not include the registration number and/or the application serial number, the register the mark appears on (Principal or Supplemental), whether the registration and/or application is currently live or not, etc. Also, third-party applications have virtually no probative value on the issue of registrability, as pending applications are evidence only of the fact that an application was filed on a particular date.

³ Of the five exceptions, one registration is for sporting goods (as explained earlier herein), two are for the term "eagle" in a foreign language and each with a design feature (Registration Nos. 1421201 and 1460886), one is for the mark EAGLES and the identification of goods specifically recites clothing items "relating to the music group 'The Eagles'" (Registration No. 2161179), and one is for the mark EAGLES and design and is owned by the University System of Georgia (Registration No. 1697700).

example, EAGLE CANYON, EAGLE POINT, BLUE EAGLE, GREEN EAGLE, SCREAMIN' EAGLE).

Most importantly, third-party registrations do not establish that the marks shown therein are in use, much less that consumers are so familiar with them that they are able to distinguish among such marks. There is no evidence of record of any use by any party (including applicant, the cited registrant or any third-party) of any mark including the word EAGLE for clothing.

To the extent applicant is arguing that inconsistent actions were taken by Examining Attorneys, the record history of each of the two cited registrations as well as the records of the third-party registrations are not before us. Moreover, neither the Board nor any Court is bound by prior decisions of Trademark Examining Attorneys, and each case must be decided on its own merits, on the basis of the record therein. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). See also, *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001).

Furthermore, even weak marks are entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

Turning next to a consideration of the goods involved in this case, we start with the well-settled principle that the question of likelihood of confusion in Board proceedings regarding the registrability of marks, must be determined based on an analysis of the goods or services identified in applicant's application vis-a-vis the goods or services recited in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Further, it is also well settled that goods or services need not be identical or even competitive to support a finding of likelihood of confusion. Rather, it is enough that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they emanate from or are in some way associated with the same producer or that there is an association between the producers of each party's goods or services. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992); and *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

In this case, applicant's identified goods are "men's tailored clothing, namely, suits, sport jackets, coats and slacks" and registrant's identified goods are "woven dress-shirts, negligee shirts, and undershirts, drawers, and sleeping garments" and "shirts, swim trunks, sweaters and neckties." Clearly, these are not identical items of clothing. The Examining Attorney argues that these goods are closely related and she submitted into the record printouts of pages from a few third-party websites (e.g., Jos. A Bank, The Foursome, Land's End) showing that these entities offer tailored men's clothing, including suits, shirts and ties.

Based on the record, we find that applicant's men's tailored clothing items (particularly the "suits," "sport jackets" and "slacks") and registrant's clothing items (particularly the "woven dress-shirts," "shirts" and "neckties") are related goods. See *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services").

The respective goods, as identified, would be sold in the same or at least overlapping channels of trade to the same or overlapping classes of purchasers.

With regard to the conditions of sale du Pont factor, applicant contends that its identified clothing items are expensive; that applicant's goods will be purchased with the assistance of a sales associate or an in-house tailor, while the cited registrant's goods will be purchased self-serve off the shelf; and that purchasers will use a high degree of care in selecting tailored clothing. However, applicant submitted no evidence relating to (i) the cost of either its own goods or those of the cited registrant; (ii) the respective asserted methods of sale (off the shelf or through a sales associate or tailor); and (iii) consumers' purchasing decisions with regard to tailored clothing.

Even if we assume that applicant's goods are expensive and are purchased with sales assistance and only with care, we are not convinced on this record that purchasers will be immune from confusion as to source, where, as here, identical marks are applied to closely related products. See *In re Hester Industries, Inc.*, 231 USPQ 881 (TTAB 1986).

In view of the fact that applicant's EAGLE mark is identical to registrant's mark, and the goods are closely

related (e.g., "men's tailored suits" and "shirts"), with the same or overlapping channels of trade and purchasers, we find that applicant's mark for its identified goods is likely to cause confusion with the mark in the cited registrations.

Finally, any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity to avoid confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.